

REMARKS

This Application has been carefully reviewed in light of the Office Action. Applicants appreciate the Examiner's consideration of the Application. Applicants respectfully request reconsideration and favorable action in this case.

The *Ellis* Reference

The Office Action relies on at least U.S. Patent Application Publication No. 2004/0117831 A1 to Ellis et al. ("Ellis") to reject all of the pending claims. The use of *Ellis*, however, is improper. *Ellis* is a continuation of U.S. Application No. 09/604,470 filed June 26, 2000. *Ellis* also claims priority to Provisional Application No. 60/141,501 Application No. 60/141,501 ("Ellis Provisional") filed June 28, 1999. Applicants have a filing date of April 9, 2001. Additionally, Applicants further claim priority to Applicants' Provisional Application filed April 8, 2000. As a result, Applicants respectfully submit that in order to utilize *Ellis*, the Examiner **must** rely on the June 28, 1999 filing date of the *Ellis Provisional*.

The filing date of the *Ellis Provisional* only applies to *Ellis*, however, "if the [*Ellis Provisional*] properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C 112, first paragraph." *See* M.P.E.P. § 2136.03(III) (**emphasis in original**); *see also* M.P.E.P. § 706.02(f)(1) (stating that the filing date of a provisional application may be relied upon only if the provisional application "properly supports the subject matter used to make the rejection in compliance with 35 U.S.C. 112, first paragraph"). In addition, Applicants respectfully refer the Examiner to the second example following M.P.E.P. § 706.02(f)(1), which explains 35 U.S.C. § 119(e) **requires** "a prior U.S. provisional application . . . [to have] proper support for the subject matter" of a reference in order for the subject matter to be reference-effective as of the provisional filing date. *See* M.P.E.P. § 706.02(f)(1), example 2.

The allocation of burdens requires that the USPTO produce the factual basis for its rejection of an application under 35 U.S.C. §§ 102 and 103. *In re Piasecki*, 745 F.2d1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967)). The one who bears the initial burden of presenting a *prima facie* case of unpatentability is the Examiner. *In re Oetiker*, 977 F.2d1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The Examiner thus carries the burden of establishing that the

conditions set forth in M.P.E.P. §§ 2136.03(III) and 706.02(f)(1) are met. *See In re Wertheim*, 646 F.2d 527, 531-39, 209 USPQ 554, 559-66 (CCPA 1981) (holding that “[i]f, for example, the PTO wishes to utilize against an applicant a part of that patent disclosure found in an application filed earlier than the date of the application which became the patent, it must demonstrate that the earlier-filed application contains §§120/112 support for the invention claimed in the reference patent.”) (emphasis added).

Contrary to the applicable law and the above referenced M.P.E.P. sections, the Examiner suggested during a phone interview on November 1, 2007, that Applicants have the burden to show that the *Ellis Provisional* fails to properly support the subject matter relied upon to make a rejection in compliance with 35 U.S.C. § 112, first paragraph. Although Applicants respectfully traverse for at least the reasons stated above, Applicants nevertheless previously argued in Applicants' Response filed July 17, 2007, that the *Ellis Provisional* fails to properly support the subject matter relied upon by the Office Action to make its rejections (see pages 11-12). In addition, Applicants previously argued that the *Ellis Provisional* fails to anticipate each and every limitation of Applicants' claims. Applicants note that the present Office Action fails to address these previously asserted arguments. For the convenience of the Examiner, the Applicant reasserts at least the same arguments in the following section.

Not only did the Examiner fail to address Applicants specific arguments regarding the use of *Ellis* to reject Applicants claims, the Examiner has yet to provide any evidence whatsoever that the *Ellis Provisional* properly supports the subject matter relied upon to make the rejections. Applicants respectfully request that the Examiner provide evidence that the *Ellis Provisional* properly supports the subject matter relied upon to make each rejection. In addition, Applicants respectfully request the Examiner address Applicants arguments in support of patentability, at least some of which the Applicants reassert below.

Section 103 Rejections

The Office Action rejects Claims 1, 4-10, 12-13, 15-17, and 24-25 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Application Pub. No. 2004/0117831 filed by Ellis et al. (“*Ellis*”) in view of U.S. Patent No. 5,938,737 to Smallcomb et al. (“*Smallcomb*”). The Office Action rejects Claims 2 and 14 under 35 U.S.C. § 103(a) as being unpatentable over *Ellis* in view of *Smallcomb*, and in view of U.S. Application Pub. No. 2002/0007493 filed by

Butler et al. ("Butler"). The Office Action rejects Claim 18 under 35 U.S.C. § 103(a) as being unpatentable over *Butler* in view of *Smallcomb* and in view of *Ellis*. The Office Action rejects Claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Butler* in view of *Ellis*. Applicants respectfully traverse these rejections.

Independent Claim 1, previously presented, is allowable at least because the *Ellis Provisional* fails to disclose, expressly or inherently, "providing a digital interactive set-top box coupled to a standard television, said interactive set-top box accessing said additional Internet-based content and superimposing said content on said video stream." The Office Action relies on a set-top box 26 of *Ellis* at Paragraph 0098 to disclose this limitation. *See* Office Action, Page 3. Whether or not this is correct, *Ellis* was filed after Applicants' priority date and cannot be used as a reference against Applicants' Application unless support exists for all alleged limitations in the *Ellis Provisional*—it does not. The *Ellis Provisional* fails to disclose at least the set-top box of *Ellis*. In fact, the *Ellis Provisional* merely discloses an electronic program guide. *See* *Ellis Provisional*, Page 2. As a result, the *Ellis Provisional* fails to disclose "providing a digital interactive set-top box coupled to a standard television, said interactive set-top box accessing said additional Internet-based content and superimposing said content on said video stream" of Independent Claim 1, as required by the M.P.E.P.

For at least this reason, Independent Claim 1 is allowable, as are Claims 2, 4-5, 8-10, 12-16, and 24-25 that depend therefrom. For analogous reasons, Independent Claims 11 and 18 are allowable. Reconsideration and favorable action are requested.

Claim 6 is allowable at least because the *Ellis Provisional* fails to disclose, expressly or inherently, "storing one or more of said video clips of said selected plays; summarizing said stored video clips with a graphic summary including coded indicators denoting types of plays; replaying one of said video clips upon viewer selection of a corresponding said coded indicator." The Office Action relies on claim 5 and Paragraphs 0018, 0169, and 0184 of *Ellis* to disclose this limitation. *See* Office Action, Page 5. The *Ellis Provisional*, however, not only fails to disclose "one or more of said video clips of selected plays," but also fails to disclose "summarizing said stored video clips with a graphic summary including indicators denoting types of plays" of Independent Claim 6, as required by the M.P.E.P.

For at least this reason, Independent Claim 6 is allowable, as is Claim 7 that depends therefrom. For analogous reasons, dependent Claim 24 is allowable. Reconsideration and favorable action are requested.

Independent Claim 17 is allowable at least because the *Ellis Provisional* fails to disclose, expressly or inherently, “providing taskbars displaying various accounts in the home.” The Office Action relies on a user profile of *Ellis* at Paragraph 0202 and claim 11 of *Ellis* to disclose this limitation. See *Office Action*, Page 10. The *Ellis Provisional*, however, fails to disclose the user profile of *Ellis*. In fact, it also clearly teaches away from a user profile, as described below:

Unlike user-preference-based guides, there is no mode. When one viewer in a household is done making selections, the guide is not left in a state with that viewer's preferences still intact. There is no need to “log in” and tell the system who is watching television.

See Ellis Provisional, Page 2 (emphasis added). As a result, the *Ellis Provisional* fails to disclose “providing taskbars displaying various accounts in the home” of Claim 17, as required by the M.P.E.P.

For at least this reason, Independent Claim 17 is allowable. For analogous reasons, dependent Claim 25 is allowable. Reconsideration and favorable action are requested.

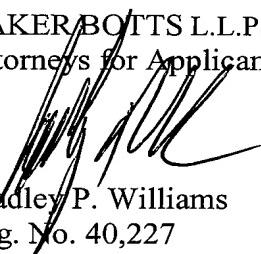
CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other apparent reasons, Applicants respectfully request full allowance of all pending Claims. If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Brad Williams, the Attorney for Applicants, at the Examiner's convenience at (214) 953-6447.

Although Applicants believe no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 20-0668 of Texas Instruments.

Respectfully submitted,

BAKER/BOTTs L.L.P.
Attorneys for Applicants


Bradley P. Williams
Reg. No. 40,227

Date: 11/15/07

Correspondence Address:

Customer Number: **23494**